No. 95-926

Supreme Court, U.S.
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1995

MARK I MARKETING CORPORATION and MARK I MARKETING CORPORATION OF AMERICA,

Petitioners,

—v.—

R.R. DONNELLEY & SONS COMPANY,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

The judgment below presents the following issues for review:

1. Are factual issues concerning what occurred during the prosecution of a patent application and the implications of a patent's prosecution history to be determined by a jury as issues of fact, or by a court as a matter of law?

PARTIES TO THE PROCEEDING

There are no parties to this case other than those appearing in the caption.

Pursuant to Rule 29.1 of the Rules of this Court, petitioners state that other than the entities named as petitioners in the caption, petitioners have no parent corporations, and neither corporation has sold shares to the public.

TABLE OF CONTENTS

Questions Presented i

Parties to the Proceeding ii

Table of Contents iii

Table of Authorities v

Petition for a Writ of Certiorari 1

Opinions Below 1

Statement of Jurisdiction 2

Statutes Involved 2

Statement of Case 3

Reasons for Granting the Writ

A WRIT OF CERTIORARI SHOULD BE GRANTED SO THAT THIS COURT CAN DECIDE WHETHER THE ISSUE OF PROSECUTION HISTORY ESTOPPEL SHOULD PROPERLY BE ADDRESSED TO A JURY, RATHER THAN AN APPELLATE COURT, AND IN ORDER TO MAINTAIN UNIFORMITY IN THE LAW SINCE AT LEAST ONE OTHER WRIT OF CERTIORARI DEALING WITH A SIMILAR ISSUE HAS RECENTLY BEEN GRANTED BY THIS COURT AND IF NO WRIT IS GRANTED IN

THIS CASE THE PETITIONERS COULD BECOME THE VICTIMS OF A LEGAL ANOMALY AND LEAD TO INCONSISTENT RESULTS IN THIS CRITICAL AREA OF PATENT LAW 7

Conclusion 12

Appendix

Decision of Federal Circuit 1a

Order and Judgment of the District Court 20a

TABLE OF AUTHORITIES

Graver Tank & Mfg. Co. v. Linde Air Products Co., 339 U.S. 605, 70 S.Ct. 854 (1950) 8

Hilton Davis Chemical Co. v. Warner-Jenkinson Co., Inc., 62 F.3d 1512 (Fed. Cir. 1995) 8, 12

LaBounty Manufacturing Inc. v. United States International Trade Commission, 867 F.2d 1572 (Fed. Cir. 1989) 9, 11

Loctite Corp. v. Ultraseal, Ltd., 781 F.2d 861, 870 (Fed. Cir. 1985) 8, 11

Markman v. Westview Instruments, Inc. 52 F.3d 967, 980 (Fed.Cir. 1995), cert. granted ___ U.S. ___, 116 S.Ct. 40 (1995) 7, 10, 12

Sanitary Refrigerator v. Winters, 280 U.S. 30, 50 S.Ct. 9 (1929) 8, 11

Smithkline Diagnostics, Inc. v. Helena Laboratories Corporation, 859 F.2d 878, 882 (Fed. Cir. 1988) 7

IN THE
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-against-

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

OPINIONS BELOW

This petition seeks review of the opinion issued by the United States Court of Appeals for the Federal Circuit on September 14, 1995 (1a*), which appears at 66 F.3d 285, 36 U.S.P.Q.2d 1095 (Fed. Cir. 1995), which affirmed the order and judgment of the District Court dated

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* Page references incorporating the letter 'a' refer to the appendix.

October 28, 1994 (20a).

STATEMENT OF JURISDICTION

In seeking review of the decision of the United States Court of Appeals for the Federal Circuit, petitioner invokes the certiorari jurisdiction conferred on this Court by 28 U.S.C. § 1254(1).

STATUTES INVOLVED

United States Constitution, Article I, Section 8, Clause 8

The Congress shall have the power...to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

United States Constitution, Amendment VII

In suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury, shall be otherwise reexamined in any Court of the United States, than according to the rule of the common law.

STATEMENT OF CASE

This patent case involves the invention by Wallace Edwards, the president of the petitioner corporations, of a pioneering printing process which permits the simulated effect of full color printing to be obtained using fewer than the four colors generally required by the industry standard process, known as Four Color Process, and which permits printing on substrates of various colors and qualities, whereas the Four Color Process requires a white high quality substrate. The advantages of this process are significant: for example, the advent of this process permitted color advertising in yellow pages telephone directories which had never before been technologically possible.

Mr. Edwards applied for and was granted United States Patent No. 4,554,241 ("'241 patent") for his process, and has used the trademark "Markolor" to describe the process.

The petitioners licensed Markolor to the Reuben H. Donnelley Corporation (not related to the respondent, R.R. Donnelley), the world's largest publisher of yellow pages directories. R.H Donnelley then introduced the Markolor process to the respondent R.R. Donnelley, which is a printing company to be used in printing R.H. Donnelley's yellow pages products.

When it became clear to the petitioners that R.R.

Donnelley was unabashedly using the Markolor process to print color advertising in yellow pages telephone directories, but refusing to pay the petitioners any royalties, the petitioners commenced this patent infringement action.

R.R. Donnelley's defense was to claim that they are not literally infringing the '241 patent. Moreover, they assert, petitioners are barred from claiming that the process being used by R.R. Donnelley is protected under the doctrine of equivalents by virtue of patent prosecution history estoppel. The basis of this latter assertion is that when Mr. Edwards first applied for his patent, his application was rejected due to prior art, and was not accepted until he submitted a new application paring down his patent claims.

R.R. Donnelley moved for summary judgment in the United States District Court for the Northern District of Illinois.[1] Summary judgment was granted to R.R. Donnelley ostensibly on the ground of the District Judge's finding that there was no triable issue of fact as to whether the process being used by R.R. Donnelley was within the prior art. (34a). The decision of the District Court did not turn on the issue of prosecution history estoppel.

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[1] The action was originally commenced in the Southern District of New York, but venue was transferred to the Northern District of Illinois upon R.R. Donnelley's motion.

An appeal was taken, which was heard by the United States Court of Appeals for the Federal Circuit.

The Federal Circuit affirmed the District Court's decision, but on an entirely different ground than that relied upon by the District Court. The focus of the Federal Circuit's decision was the doctrine of prosecution history estoppel, which had not been the focus of the District Court's decision.

In writing its decision turning on prosecution history estoppel, the Federal Circuit delved into, and decided as a matter of law, the factual issues of the prosecution history of the '241 patent, and actually decided these factual matters on the basis of a cold appellate record, including directly conflicting expert affidavits submitted in the context of a summary judgment motion, without any trial ever having been held on those or any other issues in this case. Thus engaging in factual determinations at the appellate level, the Federal Circuit reached the factual decision that the prosecution history of the '241 patent showed that Mr. Edwards had limited the scope of his patent claims to exclude processes such as that which R.R. Donnelley correctly or incorrectly claimed to be using, and affirmed the District Court's decision to grant summary judgment to R.R. Donnelley.

Petitioner now seeks a writ of certiorari to resolve the question of whether the Federal Circuit properly invaded the province of the jury to decide issues of fact

that were not even directly addressed by the District Court, and which were presented to the Federal Circuit only as a matter of legal argument without the benefit of a trial or a fully developed record.

Moreover, even if the Federal Circuit had relied on the same grounds as the District Court—that there was no issue of fact regarding whether R.R. Donnelley was using a prior art—petitioner would seek a writ of certiorari as this, too, would have been error since the District Court's summary judgment decision was made in the face of directly conflicting witness and expert affidavits and the issue of what process was being used and whether it infringed the patent was clearly in dispute.

REASONS FOR GRANTING THE WRIT

A WRIT OF CERTIORARI SHOULD BE GRANTED SO THAT THIS COURT CAN DECIDE WHETHER THE ISSUE OF PROSECUTION HISTORY ESTOPPEL SHOULD PROPERLY BE ADDRESSED TO A JURY, RATHER THAN AN APPELLATE COURT, AND IN ORDER TO MAINTAIN UNIFORMITY IN THE LAW SINCE AT LEAST ONE OTHER WRIT OF CERTIORARI DEALING WITH A SIMILAR ISSUE HAS RECENTLY BEEN GRANTED BY

THIS COURT[2] AND IF NO WRIT IS GRANTED IN THIS CASE THE PETITIONERS COULD BECOME THE VICTIMS OF A LEGAL ANOMALY AND LEAD TO INCONSISTENT RESULTS IN THIS CRITICAL AREA OF PATENT LAW.

The crux of this petition for a writ of certiorari is the question of which issues in a patent case may be decided by the court, and which issues the court must leave to be decided after trial by the jury. In this case, the Federal Circuit decided issues involving the implications of the prosecution history of the '241 patent. Petitioner submits that these were clearly factual issues, *Smithkline Diagnostics, Inc. v. Helena Laboratories Corporation*, 859 F.2d 878, 882 (Fed. Cir. 1988) (holding that interpretation of patent prosecution history is a factual matter) that should not have been resolved by the Federal Circuit since there were questions of fact, but should rather have been left for the jury to resolve after a trial.

The "prosecution history" of a patent refers to the proceedings in the Patent and Trademark Office that led up to the issue of a patent. *Markman v. Westview Instruments*,

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[2] A writ of certiorari has been granted in *Markman v. Westview Instruments, Inc.*, ___ U.S. ___, 116 S.Ct. 40 (1995). A petition for a writ of certiorari has been filed but not yet decided in *Hilton Davis Chemical Co. v. Warner-Jenkinson Co., Inc.*, 62 F.3d 1512 (Fed. Cir. 1995), a case dealing with similar issues.

Inc. 52 F.3d 967, 980 (Fed.Cir. 1995), cert. granted ___ U.S. ___, 116 S.Ct. 40 (1995). Prosecution history estoppel is a doctrine which bars a patentee from asserting a claim to patent rights over a claim which was relinquished during the patent application process. *Loctite Corp. v. Ultraseal, Ltd.*, 781 F.2d 861, 870 (Fed. Cir. 1985). Prosecution history estoppel functions as a check against the doctrine of equivalents, which permits a patentee to maintain a patent infringement claim when another person uses a process or device which is the functional equivalent of the patent. See, *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605, 70 S.Ct. 854 (1950). Thus, although the doctrine of equivalents can operate to expand a patent beyond its literal verbiage, the prosecution history of a patent, once it is fully determined, can be used to prevent the expansion of a patent's claims into areas that were specifically excluded from the patent claim during the patent application process. *Hilton Davis Chemical Co. v. Warner-Jenkinson Co., Inc.*, 62 F.3d 1512 (Fed. Cir. 1995).

The doctrine of equivalents and the use of prosecution history estoppel to limit the doctrine of equivalents have in the past been viewed as creatures of equity. See, *Loctite*, 781 F.2d at 870 and 871 n. 7. As creatures of equity, these doctrines would be applied purely as matters of law. However, the Federal Circuit, relying on this Court's decision in *Sanitary Refrigerator v. Winters*, 280 U.S. 30, 50 S.Ct. 9 (1929), has very recently

made it clear that the doctrine of equivalents is not a matter of equity and that any decision in a patent case turning on the doctrine of equivalents is to be decided by a jury or the District Court where it is the trier of fact. *Hilton Davis*, 62 F.3d 1520-21.

Clearly, the *Hilton Davis* decision that issues of the doctrine of equivalents are factual issues to be decided by the jury raises a question as to whether issues of prosecution history estoppel, which exists as a check on the doctrine of equivalents, should also be decided by the jury.

The Federal Circuit's decisions prior to *Hilton Davis* do not assist in resolving this issue. Although the Federal Circuit decided in *Smithkline Diagnostics, Inc.* v. *Helana Laboratories Corporation*, a 1988 decision, that the interpretation of a patent prosecution history is a factual matter, the Federal Circuit's 1989 decision in *LaBounty Manufacturing Inc.* v. *United States International Trade Commission*, 867 F.2d 1572 (Fed. Cir. 1989), which was explicitly relied upon by the Federal Circuit in the case now at bar (16a), reached the conclusion that "the application of prosecution history estoppel is a question of law."[3] *Id*, 867 F.2d at 1576.

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[3] It is not entirely clear that when the *LaBounty* court wrote that "application of prosecution history estoppel is a matter of law" it intended to overrule the *Smithkline* court's decision that the determination of "what occurred during the prosecution history" is

(continued next page)

The holding that the court may "look as a matter of law to the prosecution history" was recently repeated in *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir 1995), cert. granted ___ U.S. ___, 116 S.Ct. 40 (1995), a case which preceded *Hilton Davis* by four months. Since this Court has granted a writ of certiorari in *Markman* (that appeal is scheduled to be fully briefed by the end of December, 1995), the continuing validity of the Federal Circuit's holding in that case cannot be certain at this time. See, *Id.*, 52 F.3d 999-1026 (Newman, J. dissenting).[4] It is

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an issue of fact. Clearly, determining factually what happened during the prosecution of a patent can be seen as distinct from applying that prosecution history to the interpretation of a patent claim, and thus both holdings could co-exist.

However, in the case at bar, the Federal Circuit cited *LaBounty*—without even mentioning *Smithkline*—and proceeded to interpret and apply the prosecution history of the '241 patent, although no factual determination of what occurred during the prosecution of the '241 patent was ever made by the District Court and the relevant facts were never presented to a jury.

[4] In her dissenting opinion in *Markman*, Judge Newman argues powerfully that the issues patent infringement and prosecution history estoppel should be left to the jury. Directly addressing prosecution history estoppel, Judge Newman wrote:

> The majority refers to the "undisputed" prosecution history, in asserting that there are no factual aspects to this evidence. Indeed, the official government record is fixed. But the significance of the exchanges, compromises and explanations contained in the correspondence between the inventor and the examiner; the inferences to be drawn as to the technology, the invention and the

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unclear why the Federal Circuit's decision in the case at bar, which was handed down over five months after *Markman*, that a patent's prosecution history can be decided as a matter of law by the court relied on *LaBounty* rather than the more recent decision in *Markman*.

Despite the Federal Circuit's decision in *Markman*, uncertainty arises with regard to the question of whether the prosecution history of a patent is to be determined as an issue of law or fact. The *Loctite* decision, which assumed that the doctrine of equivalents and prosecution history estoppel are creatures of equity, was the foundation of the *LaBounty* decision relied on by the Federal Circuit in the case at bar to determine the prosecution history as a matter of law, but the Federal Circuit's decision in *Hilton Davis*, which is based on this Court's venerable decision in *Sanitary Refrigerator*, calls the continued vitality of *LaBounty*, and any other decision holding that the doctrine of equivalents and prosecution history estoppel can be determined by the courts as a matter of law, into question.

> meaning and scope of now-disputed technologic terms or words of art; may depend on this and other evidence. If disputed, their finding is for the trier of fact. The meaning significance, and weight of the content of a documentary record does not become a matter of law simply because the content of the record is not in dispute.

Markman, 52 F.3d at 1004 (Newman, J. dissenting).

Since a petition for a writ if certiorari has been granted in *Markman*, ___ U.S. ___, 116 S.Ct. 40, and according to the Supreme Court Clerk's Office a writ of certiorari has been petitioned for in *Hilton Davis*, and the confusion arising from the interplay of these two decisions directly affects the question of whether the decision below in this case was correctly decided, petitioner submits that a writ of certiorari should be granted in this case as well.

Not to grant a writ of certiorari in this case could lead to an anomalous result if the decision in *Markman* should be reversed and the decision in *Hilton Davis* should be sustained, since that would mean the precedential underpinnings of the Federal Circuit's decision in this case would be undermined while the decision in this case would be left unchanged. Granting a writ of certiorari would permit this Court to make certain that such an inconsistent outcome does not obtain, and also that the petitioner is not made the victim of a legal anomaly, unable to obtain the result that this Court's decision in *Markman* could require.

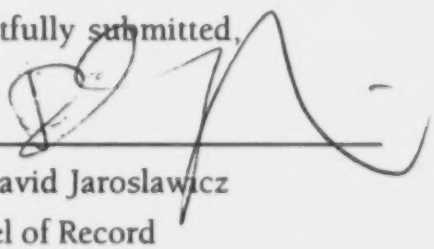
CONCLUSION

For the reasons set forth herein, petitioners respectfully request that this Court grant a writ of certiorari so that this Court can address the issue of whether the determination of issues of fact where there is

a defense of prosecution history estoppel are issues of fact for a jury, and to prevent the possibility of the petitioner becoming the victim of a legal anomaly if the decision underlying the Federal Circuit's decision in this case is overruled.

Dated: December 11, 1995

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